

Oct. 12, 2006 3:42PM 9547233871

RECEIVED
CENTRAL FAX CENTER

No. 3769 P. 12

OCT 12 2006

Application S/N 10/722,866
Amendment dated: October 12, 2006
Response to Office Action dated: June 5, 2006

CE11826JME – Tupler, et al.

REMARKS/ARGUMENTS

Claims 1-4 and 7-22 remain pending in the application, as claims 5 and 6 have been previously canceled without prejudice. In the Office Action, claim 21 was objected to because of an informality, and claim 22 was rejected under 35 U.S.C. 112, first paragraph. In addition, claims 1-4 and 7-22 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,009,336 to Harris, et al. (Harris).

In view of the objection to claim 21, that claim has been amended in accordance with the Examiner's requirement. Concerning the 112 rejection of claim 22, Applicants note that the purpose of section 112, first paragraph, is to ensure that there is an adequate disclosure of the invention for which patent rights are sought. Kennecott Corp. v. Kyocera Int'l., Inc., 835 F.2d 1419, 1421 (Fed. Cir. 1987). Generally, although the applicant does not have to describe exactly the subject matter claimed, the description must clearly allow persons of ordinary skill in the art to recognize that the applicant invented what is claimed. In re Daniels, 144 F.3d 1452, 1456 (Fed. Cir. 1998). Moreover, “[b]y disclosing . . . in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory, or advantage *even though he says nothing concerning it.* Id. at 1422 (emphasis added). The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. In re Smythe, 480 F.2d 1376, 1384 (CCPA 1973).

Here, Applicants have invented a display that can be pivoted in an X direction, a Y direction or any combination of X and Y directions (see FIG. 1 and paragraph 0019). While Applicants admit that these references of FIG. 1 are not expressly referred to as “axes” or “second axis” in paragraph 0019 (they are referred to as X and Y directions), it

Application S/N 10/722,866
Amendment dated: October 12, 2006
Response to Office Action dated: June 5, 2006

CE11826JME - Tupler, et al.

is important to note that one of ordinary skill in the art would most certainly recognize that the display has at least a second axis that is substantially parallel to the top surface of the display, given the display's ability to pivot in either an X or Y direction (in addition to the perpendicular axis (115)). In fact, one can argue that a person skilled in the art of pivotable displays would interpret the X and Y arrows of FIG. 1 as second axes and that - given their orientation in comparison to the display - they are parallel to a top surface of the display.

Concerning the 102 rejections, Applicants note that independent claims 1 and 21 recite the feature that the display support includes at least one support member (130) rigidly attached to the display (110) and at least one pivot member (135) rigidly attached to the at least one support member (130) and pivotally attached to the platform (145). Applicants have carefully reviewed the Examiner's comments on pages 3 and 9 of the Office Action of June 5, 2006. Specifically, the Examiner is contending that the turret (402) - which the Examiner has attempted to equate with the pivot member (135) of the invention - is rigidly attached to the sleeve (502) and pivotally attached to the housing (108) - which the Examiner has attempted to equate with the support member (130) and the platform (145) of the invention, respectively.

Applicants respectfully submit that the structure of Harris directly contradicts the claimed subject matter. Notably, in Harris, the turret (402) is *pivotally* attached to the sleeve (502) and is *rigidly* attached to the housing (108) (see FIG. 5 and col. 8, lines 38-45). It is clear in Harris that the housing (110) rotates while the other housing (108) remains stationary. If Harris were interpreted in accordance with the Examiner's assertions, the handheld device described could not be properly operated, as the housing (108) is not designed to move around the housing (110).

Application S/N 10/722,866
Amendment dated: October 12, 2006
Response to Office Action dated: June 5, 2006

CE11826JME – Tupler, et al.

Referring to claim 22, Applicants note that the claim has been amended to clarify that the device includes means for connecting an input for the device in response to one or more tactile forces transferred to the support structure and means for permitting the display to rotate about the first axis and to rotate about the second axis in response to the one or more tactile forces. Support for this amendment can be found in paragraph 0019 and in FIG. 1. No new matter has been added in view of this amendment. As noted in Applicants' Amendment of March 16, 2006, the housings (108, 110) shown in Harris are limited to rotation around a single axis, one that is perpendicular to the top or bottom surfaces of the housings (108, 110).

In view of the above, Applicants believe that independent claims 1, 21 and 22 are patentable over the prior art. Applicants also believe that those claims that depend from these independent claims are now patentable, in view of both their dependence from these claims and their independent patentability. Reconsideration and withdrawal of the rejection of the claims is respectfully requested. Passing of this case is now believed to be in order, and a Notice of Allowance is earnestly solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references. Moreover, it must be understood that the claims are not limited to the embodiments disclosed in the specification and that the reference numerals of the application that are used in the description above are merely intended to provide clarity to Applicants' arguments.

Oct. 12. 2006 3:42PM 9547233871

RECEIVED
CENTRAL FAX CENTER

No. 3769 P. 15

OCT 12 2006

CE11826JME - Tupler, et al.

Application S/N 10/722,866
Amendment dated: October 12, 2006
Response to Office Action dated: June 5, 2006

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicants' attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

The Commissioner is hereby authorized to charge any necessary fee, or credit any overpayment, to Motorola, Inc. Deposit Account No. 50-2117.

Respectfully submitted,

By: 

Larry G. Brown
Attorney of Record
Reg. No.: 45,834

SEND CORRESPONDENCE TO:

Motorola, Inc.
Law Department - MD 1610
8000 W. Sunrise Blvd.
Plantation, FL 33322

Customer Number: 24273

Tel: (954) 723-4295 direct line
Tel: (954) 723-6449 main line
Fax No.: (954) 723-3871